

REMARKS

Claims 18 and 20-22 are pending in the subject application. Claim 18 has been amended. Accordingly, upon entry of this Amendment claims 18 and 20-22 will be pending and under examination.

Applicant maintains that these amendments to the claims do not raise any issue of new matter, and that these claims are supported by the specification as originally filed.

Rejection under 35 U.S.C. §112

In the March 5, 2007 Office, the Examiner rejection claims 18 and 20-22 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regard as the invention. In claim 18, the phrase "...equal to or less than a credit card thickness" defines the pill card in reference a credit card which is undefined and has not been positively claimed rendering the claims vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such

language. In claim 18, the phrase "resealing mechanism" lacks proper antecedent basis since the specification fails to disclose such phrase.

In response to the Examiner's rejection, applicant has amended claim 18 to particularly point out and distinctly claim the subject matter which applicant claims as the invention, and furthermore, respectfully traverses on the ground that support in the specification can be found for claims 18 and 20-22, as amended, specifically for the above referenced phrases.

There is no *in haec verba* requirement for newly amended claims in order to meet the written description requirement under 35 U.S.C. §112 first paragraph, rather, these claim limitations may be supported in the specification through implicit or inherent disclosure. MPEP §2163 I.B. Furthermore the standard for determining compliance with 35 U.S.C. §112 first paragraph, requires a factual inquiry as to whether the specification conveys with reasonably clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as claimed. MPEP §2163.02.

Again, the subject matter of the claim need not be literally described in order for the disclosure to satisfy the description requirement. *Id.*

Briefly, pending claim 18 recites a wallet pill card comprising a top, a bottom, a left side, a right side, a front side, and a back side, and a cavity, wherein said cavity is located on and extends outwardly from said top of said wallet pill card, and wherein said cavity comprises a thickness designed to contain oral medical tablets, and further comprises a cavity resealing mechanism, wherein said portion of said wallet pill card extending from said cavity to said bottom comprises a thickness that is substantially equal to or less than a credit card thickness.

As illustrated below, applicant respectfully asserts that support for amended claim 18, specifically a "resealing mechanism" exists in several locations in the specification. Initially, applicant directs the examiner to the following excerpt which states:

The wallet pill card may be disposable for a single use or reusable for multiple uses. In a reusable embodiment of the present invention, additional medication is placed and sealed,

through sealing mechanisms known in the art, in the sealed cavities once they are opened and emptied. Therefore, the wallet pill card may be reused with additional medication.

Summary of the Invention, page 5, line 9 through 14.

Applicant respectfully asserts that the above-referenced portion of the specifications provide proper support for amended claim 18, specifically a "sealing mechanism", especially in light of the above-mentioned standard, created by MPEP §2163 I.B. Applicant ergo asserts that the present invention, as described above, illustrates a wallet pill card containing a cavity with a sealing mechanism.

In view of the applicant's amendments to claim 18, in conjunction with applicant's arguments specifically illustrating support for amended claim 18, applicant respectfully requests the Examiner to remove this ground of rejection.

Rejection under- 35 U.S.C. §103

In the March 5, 2007 Office Action, the Examiner rejected claim 18 under 35 U.S.C. 103(a) as being

unpatentable over Bullock in view of Robertson (6,516,950) or Bartell et al. (4,889,236; hereinafter Bartell'236) Bullock discloses a card (1) comprising a top, a bottom, a left side, a right side, a front side, a back side and a cavity (2) for holding a pill. The cavity located on and extends outwardly from the top of the card and a cavity resealing mechanism (3). Bullock further discloses the card having a substantially rectangular shaped and the bottom comprises a thickness of the card.

To the extent that Bullock fails to show the bottom of the card comprises a thickness equal to or less than a credit card thickness, Robertson teaches a credit card-sized carrier for holding a pill. Robertson also teaches that a credit card have a thickness of about 0.05 inches (column 3, lines 55-56). Bartell'236 shows a credit-card-sized blister-pack medication package (10) having a shape substantially similar to a credit card comprising a bottom having a thickness. The bottom of the card including an upper portion (100) with a thickness preferably about 0.0265 inches, a top surface (120) of the upper portion is coated with a clear layer having a thickness preferably about 0.00185, a bottom surface (130) of the upper portion

is coated with a clear layer having a thickness preferably about 0.0015 inches, a middle portion (200) having a thickness preferably about 0.0075 inches, a lower portion (400) having a thickness preferably about 0.002 inches and two heat seal layers (510, 520) with each layer having a thickness of about the same thickness of the lower portion (Figure 2 and column 2, line 41 to column 3, line 38).

Therefore, the thickness of the bottom of the card is equal to $(.0265+.00185+.00185+.0015+.0075+.002+2*(.002))=0.04185$ inches which is less than a credit card thickness. Therefore, it would have been obvious to one having ordinary skill in the art in view of Robertson or Bartell'236 to modify the card of Bullock so the thickness of the bottom of the card is equal to or less than a credit card thickness to reduce the material and also to provide more convenience for the user to carry the card in the wallet.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 18 above, and further in view of Collens (4,669,613) or Boone (4,870,764). The card of Bullock as modified further

fails to show writing being located on the front of the card below the cavity. Bartell'236 further shows the card comprises writing (20) such as calendar and any other desired product identification information (column 2, lines 49-51) Collens shows a card (1,2) having writing located on the front of the card below cavities (4-6, rotate the card of Figures 1-2 in 90 degrees clockwise). Boone teaches a card (1,2) comprising a cavity (7,15) and writing disposed on the front of the card below the cavity(see the Figure). It would have been obvious to one having ordinary skill in the art in view of Bartell'236, Collens or Boone to modify the card of Bullock as modified so the card includes writing disposed on the front of the card and below the cavity to provide more convenience for the user.

As to claims 21 and 22, regarding the writing comprises an advertisement or instructions as taught by the prior art, it would have been obvious to one having ordinary skill in the art to modify the writing so it comprises an advertisement or instructions because it has been held that the printed matter merely taught a new use for an existing product and thus couldn't impart patentability. In re Ngai.

Applicant incorporates, reaffirms and respectfully requests reconsideration of the above arguments in responding to the Examiner's rejection of the instant invention based on 35 U.S.C. §103(a). While Applicant requests reconsideration of the above arguments, at this time Applicant focuses on the commercial success of the instant invention to support a conclusion of nonobviousness.

Applicant has attached two declarations to this amendment that attest to the commercial success of the instant invention. Applicant maintains that the field in which the instant invention resides (medical pill holders) is competitive and lucrative that improvements are implemented as soon as they are recognized. The instant invention has enjoyed substantial commercial success since it was first introduced because consumers recognize and realize the innovative steps of combining a medical pill holder that has the ability to reside in an individual's wallet while properly securing medical tablets.

M.P.E.P. §716.03 asserts that an establishment of a nexus between the claimed invention and evidence of commercial success supports a contention of nonobviousness.

The first declaration addresses the commercial success of the instant invention realized by the applicant, as well as supporting exhibits from various manufacturers and publications. Applicant also maintains that he possessed no market share for pill containment devices prior to inception of the instant invention. Furthermore applicant did not advertise or market any pill containment device prior to the instant invention. Moreover, Applicant first entered the pill containment market place in January 2004, when the instant invention appeared in a magazine article. Since the introduction of the instant invention, applicant has sold over 30,000 units on his website, in addition to filling an order for over 500,000 units for Bayer Levitra Mexico as shown by **Exhibits F & G** (Higgins Declaration ¶ 21) in the accompanying declaration of the applicant.

As a result, applicant's market share prior to the instant invention was zero, clearly demonstrating that the purchase of the claimed devices were not purchases normally

tied to the applicant. Furthermore, applicant has provided numerous journal articles commenting on the uniqueness of the instant invention and the niche that the device fills in the market place.

The second declaration addresses the commercial success of the instant invention in terms of the volume of sales, specifically to large Fortune 500 companies. Furthermore, this declaration also addresses the novelty of the instant invention, and the fact that no other pill containment device is currently in the market place that functions like the instant invention. Specifically, the declaration addresses how the instant invention, as claimed with the thickness of a credit card, allows for a perfect fit in an individual's wallet.

Applicant respectfully submits that:

- (1) in view of the market for new innovative preventative medical devices, specifically pill containment devices; and
- (2) in view of the financial rewards involved,

if combining the two innovative features was obvious as the Examiner suggests, someone would have done so before the Applicant.

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 12-0115.

In the event that an extension of time is required to file this response, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 12-0115.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Adam J. Bruno, Applicant's Attorney at (617) 720-0091 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in

Appl. No. 10/663,931

Reply to Office action of March 5, 2007

Page 15 of 16

condition for allowance and such action is earnestly solicited.

Respectfully Submitted

6/4/2007 Adam J. Bruno
Date Adam J. Bruno
Attorney for the Applicant
Reg. No. 58,390

Adam J. Bruno
Lambert & Associates
92 State Street
Boston, MA 02109
617-720-0091

Appl. No. 10/663,931

Reply to Office action of March 5, 2007

Page 16 of 16

CERTIFICATE OF MAILING

I hereby certify that this Amendment is being deposited with the United States Postal Service in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with sufficient first class postage thereon on the date shown below.



Date: 6/4/2007
Adam J. Bruno
Adam J. Bruno